

REMARKS

The last Office Action has been carefully considered.

It is noted that the drawings, the abstract of the disclosure, and the disclosure are objected to and the claims are rejected under 35 U.S.C. 112 first and second paragraph.

The claims are also rejected under 35 U.S.C. 103(a) over the patent to Bitter in view of the patent to Tsai, and for some claims also in combination with the patent to Zagar.

In connection with the Examiner's formal objections and rejections, applicants have amended the specification to define the first and second parts of the impact mechanism and identified them with reference numerals 28a and 28b.

The abstract of the disclosure has been submitted on a separate page, as a new abstract, so that a marked-up copy is not needed.

The claims have been amended exactly in correspondence with the Examiner's suggestions expressed in paragraphs 4-7 of the office action.

The Examiner's highly beneficial suggestions for making corresponding changes has been gratefully appreciated. It is believed that with the changes specified herein above the Examiner's grounds for the formal objections and rejections should be considered as no longer tenable and should be withdrawn.

Turning now to the Examiner's grounds to the rejection of the claims, it is respectfully submitted that the patent to Bitter discloses a hammer drill as described by the Examiner. The patent to Tsai teaches an arresting device for use in an electric tool and the like. The point at issue is where a person skilled in the art would place the arresting device by Tsai in an electric tool, for example in the hammer drill by Bitter.

The patent to Tsai is very clear in this point. The arresting device is to be placed "... in an output shaft of an electric hand tool ..." as explained in column 1, lines 58-59. It further indicates that: "the lock mechanism is disposed between an inner shaft 10 and an outer shaft 60 of the output shaft", as described in column 2, lines 33-35. There is absolutely

no reason for anyone skilled in the art to place the arresting device at any other place than in the output shaft of the electric tool.

The Examiner stated that it would have been obvious to one having ordinary skill in the art to have added the automatic output shaft arresting device taught by Tsai to the drill taught by Bitter in such a way that it replaces a portion of the motor shaft 25 taught by Bitter (paragraph 8, last sentence). In order not contradict Tsai who teaches to place the locking device in an output shaft, the Examiner calls the shaft 25 "motor output shaft" (paragraph 14, first sentence). In the Examiner's opinion this is the reason why it is possible to place the locking device there because shaft 25 is an "output shaft".

In applicant's opinion it is irrelevant whether the shaft 25 is called "motor shaft" as Bitter calls it or motor output shaft as the Examiner does. Tsai is clear in saying "output shaft of an electric hand tool " (column 1, lines 58 and 59 and lines 18-19). It is not the output shaft of the motor but of the tool. The output shaft of a tool is the shaft which comes out of the tool and which rotates the spindle of the tool and which provides the outputting torque. Tsai confirms that in stating: "...output shaft... for outputting torque" (column 2, lines 35-36). In light of the patent to Tsai anything else does not

make sense because it is the output shaft of the tool or the spindle on the output shaft of the tool which is the object to be locked and not any other component inside any gearing mechanism of the tool. It is not the gearing or any component therein which is to be locked but instead the spindle of the output shaft of the tool. It does not also make any sense to place the locking device at any place away from the component to be locked: THE OUTPUT SHAFT OF THE TOOL. It is noted that these facts of the case are independent of how someone calls any component inside the tool.

In the applicant's invention the locking device is placed not at the output shaft of the tool but instead at the intermediate shaft. It provides for significant advantages: a locking device is not subjected to strikes and the torque of the device caused by shocks or anything alike is reduced by the gearing. However, these advantages have not been known by the time the present application was filed. Any reasoning that someone skilled in the art would have placed the locking device anywhere else but in the output shaft of the tool is therefore hindsight reasoning.

If for some unknown reasons a person skilled in the art combines the teachings of the patents to Bitter and Tsai he would arrive at a hand tool with an arresting device placed in the output shaft of the hand

tool. In contrast, the applicant's invention deals with a hand drilling machine where the arresting device:

1. is arranged at an intermediate shaft; and
2. is not subjected to strikes.

First of all, the intermediate shaft is definitely not the output shaft of the tool. The term "intermediate" is meant to make clear that the arresting device is placed at another shaft but not at the output shaft of the tool. In addition, it is defined that in the claims that the intermediate shaft is extending parallel to the driving spindle. It makes it clear that the intermediate shaft can not be the output shaft of the tool, because one shaft can not extend parallel to itself. Therefore this feature clearly distinguishes the present invention from the prior art. Secondly, an arresting device which is placed in an output shaft is positively subjected to strikes. Strikes have to be transmitted by the output shaft and there is no other possibility. Therefore, an arresting device which is not subjected to strikes can definitely not be placed in or at an output shaft of the tool. Even this feature alone therefore serves for distinguishing the present invention from the prior art.

It is believed to be clear that the present invention defines a power tool which includes the new features that are not disclosed in the references or their combination. In order to arrive at the applicant's invention the references have to be fundamentally modified by including into them exactly those features which were first proposed by the applicants. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in *re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Definitely, the references do not contain any hint or suggestion for modification of their constructions so as to provide an arresting device arranged at an intermediate shaft and not subjected to strikes.

As explained herein above, the present invention provides for the highly advantageous results which can not be accomplished by the constructions disclosed in the references.

It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case *Ex parte Tanaka, Marushima and Takahashi* (174 USPQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicants' result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

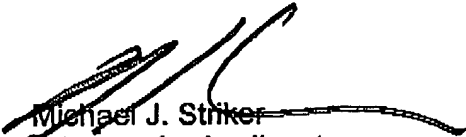
In view of the above presented remarks and amendments, it is believed that the independent claims currently on file should be considered as patentably distinguishing the present invention from the prior art and they should be allowed.

As for the dependent claims, these claims depend on the independent claims, they share its presumably allowable features, and therefore it is respectfully submitted that these claims should be allowed as well.

Reconsideration and allowance of present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Any costs involved should be charged to the deposit account of the undersigned (No. 19-4675). Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



Michael J. Striker
Attorney for Applicants
Reg. No. 27233